

Remarks

This Application has been carefully reviewed in light of the final Office Action mailed April 7, 2004. Applicants believe all pending claims are allowable over the rejections made by the Examiner, and Applicants have not amended any of the claims. Applicants respectfully request reconsideration and allowance of all pending claims.

I. Applicants' Claims are Allowable over the Proposed *Gardner-Nattkemper* Combination

The Examiner rejects Claims 1-5, 8-23, 26-40, 43-45, and 48-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,023,474 to Gardner, et al. ("*Gardner*") in view of U.S. Patent 5,999,518 to Nattkemper, et al. ("*Nattkemper*"). Applicants respectfully disagree.

For example, independent Claim 1 recites:

A system for determining subscriber information, comprising:
an access server coupled to a plurality of subscribers using a communication network and operable to receive a communication from a particular subscriber using a particular one of a plurality of virtual circuits associated with the communication network;
a memory coupled to the access server and operable to store:
subscriber information for the plurality of subscribers; and
path information for the plurality of subscribers, wherein the subscriber information for the particular subscriber is indexed by the path information for the particular subscriber, the path information for the particular subscriber identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server; and
a processor coupled to the memory and operable to:
compare the path information of the particular subscriber to the particular virtual circuit used to receive the communication from the particular subscriber; and
determine subscriber information for communication to the particular subscriber based on the comparison.

In contrast, *Gardner* merely discloses a system for interfacing a GR-303 system with a broadband system, which can be an ATM system. (Abstract) The invention can process the GR-303 signaling to select ATM connections and then inter-work the GR-303 connections with the selected ATM connections. (Abstract) *Gardner*, whether considered alone or in combination with *Nattkemper* or knowledge generally available to those having ordinary skill

in the art at the time of invention, fails to teach, suggest, or disclose various limitations recited in Claim 1. Applicants address example distinctions below.

A. The Proposed *Gardner-Nattkemper* Combination Fails to Teach, Suggest, or Disclose an "Access Server" as Recited in Claim 1

Gardner fails to teach, suggest, or disclose “an access server coupled to a plurality of subscribers using a communication network and operable to receive a communication from a particular subscriber using a particular one of a plurality of virtual circuits associated with the communication network,” as recited in Claim 1. The Examiner apparently equates the broadband system interface 300 disclosed in *Gardner* with the access server recited in Claim 1. (See Office Action, Page 2) As disclosing “operable to receive a communication from a particular subscriber using a particular one of a plurality of virtual circuits associated with the communication network,” the Examiner cites mux 350 disclosed in *Gardner*. Applicants respectfully submit that *Gardner* does not support this interpretation. As disclosed in *Gardner*, mux 350 of *Gardner* is contained within broadband system interface 300. (See Figure 3) According to *Gardner*, “[m]ux 350 is operational to receive GR-303 formatted communications over connections 330 and 332 and links 331 and 333. The bearer channels from connections 330 and 332 and the signaling channels from links 331 and 333 are in the well known DS0 format.” (Column 4, Line 64 through Column 5, Line 1) *Gardner* discloses that mux 350 of broadband system interface 300 receives calls from callers (e.g., users of telephones 210-215) in DS0 format via remote digital terminals 220 and 222. (See Figure 3)

According to *Gardner*, “mux 350 is also operational to *convert* DS0s into ATM cells with selected Virtual Path Identifiers/Virtual Channel Identifiers (VPI/VCI)s.” (Column 5, Lines 14-16; emphasis added) Thus, *Gardner* merely discloses that mux 350, which is a part of broadband system interface 300 (which the Examiner equates with the access server recited in Claim 1), receives DS0 signals and *converts* those DS0 signals into ATM cells. However, *Gardner* fails to teach, suggest, or disclose that its broadband system interface 300 is “operable to receive a communication from a particular subscriber using a particular one of a plurality of virtual circuits associated with the communication network,” as recited in Claim 1. *Nattkemper* fails to account for these deficiencies of *Gardner*.

B. The Proposed *Gardner-Nattkemper* Combination Fails to Teach, Suggest, or Disclose a Memory Operable to Store “Subscriber Information” and “Path Information” as Recited in Claim 1

Gardner fails to teach, suggest, or disclose “a memory coupled to the access server and operable to store . . . subscriber information for the plurality of subscribers” and “path information for the plurality of subscribers . . . the path information for the particular subscriber identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server,” as recited in Claim 1. The Examiner apparently equates resource device 1070 disclosed in *Gardner* to the memory recited in Claim 1. (Office Action, Page 2) Applicants respectfully submit that *Gardner* does not support this interpretation.

First, it is not even clear that resource device 1070 could be equated with a memory. *Gardner* states that “[r]esource device 1070 is capable of providing various resources in response to control instructions [e.g., tone detection, tone transmission, loopbacks, voice detection, voice messaging, echo cancellation, compression, and encryption]. (See Column 9, Lines 8-12) *Gardner* also states that “[r]esource device 1070 includes a processor to interpret the tones and communicate with other devices.” *Gardner* simply never discloses that resource device 1070 is or includes a memory.

Second, the portion of *Gardner* cited by the Examiner as disclosing that the memory is “operable to store . . . subscriber information for the plurality of subscribers,” as recited in Claim 1 (see Office Action, Page 2 citing Column 9, Lines 8-23), mentions nothing about subscriber information for the plurality of subscribers. The timing functions and other functionality of resource device 1070 disclosed in *Gardner* are line-specific functions that have nothing to do with “subscriber information for the plurality of subscribers,” let alone “a memory operable to . . . store subscriber information for the plurality of subscribers,” as recited in Claim 1.

Third, as disclosing “a memory . . . operable to store . . . path information for the plurality of subscribers . . . the path information for the particular subscriber identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server,” as recited in Claim 1, the Examiner refers to mux 350 disclosed in *Gardner*.

and Column 5, Lines 14-26. (*See* Office Action, Page 2) As discussed above, the Examiner equates resource device 1070 with the memory recited in Claim 1. Apparently, the Examiner is now equating the memory recited in Claim 1 with mux 350 disclosed in *Gardner*. In any event, the portions of *Gardner* cited by the Examiner as disclosing that mux 350 stores “path information for the plurality of subscribers” and that “the path information for the particular subscriber identif[ies] a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server” fail to disclose these limitations.

As discussed above, *Gardner* discloses that mux 350 is operational to *convert* DS0s into ATM cells with selected VPIs/VCIs. (Column 5, Lines 14-16; emphasis added) *Gardner* discloses that these ATM cells are transmitted over connection 340 to an ATM cross-connect device that routes the cells according to their VPI/VCI. (Column 5, Lines 17-20) According to *Gardner*, “[s]ince DS0s are bi-directional, a companion VPI/VCI will typically be pre-assigned to the selected VPI/VCI to provide a call connection back to the caller. The mux would convert ATM cells from this companion VPI/VCI into the return path of the DS0. Mux 350 makes the DS0/ATM conversions in response to control instructions from signaling processor 360 that are received over link 352.” (Column 5, Lines 20-26) While the term “pre-assigned” is used in close proximity to the term VPI/VCI in *Gardner*, a closer examination of *Gardner* reveals that *Gardner* fails to teach, suggest, or disclose “a memory . . . operable to store . . . path information for the plurality of subscribers . . . the path information for the particular subscriber identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server,” as recited in Claim 1. In particular, the pre-assignment disclosed in *Gardner* has nothing to do with “a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server,” as recited in Claim 1.

As can be seen from the above-cited portions of *Gardner*, mux 350 receives communications in the form of a DS0. Mux 350 then *converts* the DS0 into ATM cells with a selected VPI/VCI for communication to an ATM cross-connect device. A companion VPI/VCI is pre-assigned *to the selected VPI/VCI*, so that when ATM cells are received from this companion VPI/VCI, mux 350 can covert those ATM cells into the return path of the DS0, presumably so mux 350 can send those converted ATM cells on that return path. There

simply is no pre-assignment of a virtual circuit to a particular subscriber for communicating with the access server in *Gardner*. In fact, *Gardner* discloses that “[a]dvantageously, the VPI/VCI is selected on a call-by-call basis by the signaling processor,” eliminating any suggestion that they are pre-assigned to particular subscribers as recited in Claim 1. (See Column 6, Lines 63-65) Furthermore, while the DS0s may be specific to a particular telephone for a particular call, there is no disclosure, teaching or suggestion in *Gardner* that the DS0 format of the signals received from the remote digital terminals (via connections 330 and 332 and links 331 and 333) are pre-assigned to particular callers or telephones. In fact, the DS0s can apparently be used by multiple telephones. (See Figure 3 and Column 4, Line 63 through Column 5, Line 13) This further illustrates that *Gardner* fails to disclose, teach, or suggest “a memory . . . operable to store . . . path information for the plurality of subscribers . . . the path information for the particular subscriber identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server,” as recited in Claim 1. *Nattkemper* fails to account for these deficiencies of *Gardner*.

C. The Proposed *Gardner-Nattkemper* Combination Fails to Teach, Suggest, or Disclose "Subscriber Information" Indexed by "Path Information"

Gardner fails to teach, suggest, or disclose “wherein the subscriber information for the particular subscriber is indexed by the path information for the particular subscriber,” as recited in Claim 1.

First, as illustrated above, *Gardner* fails to disclose a memory operable to store “subscriber information” and “path information,” as recited in Claim 1. Thus, *Gardner* necessarily fails to teach, suggest, or disclose “wherein the subscriber information for the particular subscriber is indexed by the path information for the particular subscriber,” as recited in Claim 1.

Second, the portion of *Gardner* cited by the Examiner as disclosing subscriber information indexed by path information fails to teach, suggest, or disclose this limitation. *Gardner* discloses various tables in Figures 16-23. The Examiner specifically refers to the text associated with Figure 16. (See Office Action, Page 3 citing Column 15, Lines 14-34)

Gardner discloses that for originating circuit processing (i.e., processing for the origin of the call), the associated point code is used to enter the table. *Gardner* further discloses that for terminating circuit processing (i.e., processing for the destination of the call), the trunk group number is used to enter the table. (See Column 15, Lines 19-23) Assuming for the sake of argument only that the table illustrated in Figure 16 includes subscriber information (with which Applicants do not necessarily agree), at best this subscriber information would apparently be indexed by point codes (for originating calls) and trunk group numbers for terminating calls. The supposed subscriber information is not indexed by path information that identifies a particular virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server. Thus, *Gardner* fails to teach, suggest, or disclose “wherein the subscriber information for the particular subscriber is indexed by the path information for the particular subscriber,” as recited in Claim 1. *Nattkemper* fails to account for these deficiencies of *Gardner*.

D. The Proposed *Gardner-Nattkemper* Combination Fails to Teach, Suggest, or Disclose a Processor Operable to "Compare the Path Information Identifying the Virtual Circuit Assigned to the Particular Subscriber to the Particular Virtual Circuit Used to Receive the Communication from the Particular Subscriber"

The Examiner apparently equates signaling processor 360 disclosed in *Gardner* with the processor recited in Claim 1. (Office Action, Page 3) However, the Examiner acknowledges, and Applicants agree, that *Gardner* fails to disclose a processor “operable to compare the path information of the particular subscriber to the particular virtual circuit used to receive the communication from the particular subscriber,” as recited in Claim 1. (Office Action, Page 3) The Examiner argues that *Nattkemper* discloses this limitation. Applicants respectfully disagree.

Nattkemper merely discloses a distributed telecommunications switching subsystem that receives and distributes data packets passed between a plurality of switching subsystems or channel banks and a data packet switch. (Abstract) Each channel bank has a stored list of addresses. (Abstract) When a channel bank receives a data packet, it compares the address of the data packet to its stored list of addresses and transmits the data packet to another channel

bank if the address of the data packet does not correspond to any of the addresses in its stored list of addresses. (Abstract) The data packet is passed on until it reaches a channel bank with a matching address or else it is appropriately handled by a last channel bank in the chain. (Abstract) If the address of the data packet matches an address in its stored list of addresses, the channel bank passes the data packet through a subscriber interface card to a customer premises equipment unit correspond to the address of the data packet. (Abstract)

According to *Nattkemper*, ATM cells include information such as virtual path (VP) and virtual circuit (VC) routing information, and information concerning their termination. Each switching unit analyzes and evaluates the information included with each ATM cell to perform the above-discussed comparison with its stored list of addresses. The Examiner has cited no portion of *Nattkemper* that teaches, suggests, or discloses path information that “identif[ies] a particular virtual circuit that is pre-assigned to the particular subscriber for communication with the access server,” as recited in Claim 1. In other words, the Examiner has cited no portion of *Nattkemper* that discloses that the VCs associated with the ATM cells received by the switching units are pre-assigned to particular subscribers from which the data packets are received.

Thus, while *Nattkemper* may disclose comparing addressing information of a received data packet to a stored list of addresses of a switching unit for purposes of determining if the switching unit should process the data packet, *Nattkemper* fails to teach, suggest, or disclose a processor “operable to compare *the path information of the particular subscriber to the particular virtual circuit used to receive the communication from the particular subscriber*,” as recited in Claim 1. The path information for the particular subscriber recited in Claim 1 identifies “a particular virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server.” At a minimum, *Nattkemper* fails to teach, suggest, or disclose the path information recited in Claim 1 and, thus, necessarily fails to teach, suggest, or disclose a processor “operable to compare *the path information of the particular subscriber to the particular virtual circuit used to receive the communication from the particular subscriber*,” as recited in Claim 1.

E. The Proposed *Gardner-Nattkemper* Combination Fails to Teach, Suggest, or Disclose a Processor Operable to "Determine Subscriber Information for Communication to the Particular Subscriber Based on the Comparison"

As noted above, the Examiner apparently equates signaling processor 360 disclosed in *Gardner* with the processor recited in Claim 1. (Office Action, Page 3) However, the Examiner acknowledges, and Applicants agree, that *Gardner* fails to disclose a processor operable to "determine subscriber information for communication to the particular subscriber based on the comparison," as recited in Claim 1. The Examiner argues that *Nattkemper* discloses this limitation. Applicants respectfully disagree.

First, because *Nattkemper* fails to teach, suggest, or disclose the comparison recited in Claim 1, as discussed above, *Nattkemper* necessarily fails to teach, suggest, or disclose a processor operable to "determine subscriber information for communication to the particular subscriber *based on the comparison*," as recited in Claim 1. Additionally, the portion of *Nattkemper* cited by the Examiner as disclosing this limitation (*see* Office Action, Page 3 citing Column 6, Lines 8-35) mentions nothing about "subscriber information," let alone "determin[ing] subscriber information for communication to the particular subscriber," as recited in Claim 1. Thus, *Nattkemper* fails to teach, suggest, or disclose a processor operable to "determine subscriber information for communication to the particular subscriber based on the comparison," as recited in Claim 1.

F. The Proposed *Gardner-Nattkemper* Combination is Inadequate and Cannot Be Made

The rejection of Applicants' claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Gardner*, *Nattkemper*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify *Gardner* or *Nattkemper* in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

Applicants respectfully submit that the Examiner's conclusory assertion that it would have been obvious to combine the teachings of *Gardner* with the teachings of *Nattkemper* to arrive at Applicants' invention is entirely insufficient to support a *prima facie* case of

obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Gardner-Nattkemper* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of unrelated references to reconstruct Applicants' claims.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability

of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With regard to the proposed *Gardner-Nattkemper* combination, the Examiner indicates that "[i]t would have been obvious to a person of skill in the art at the time the invention was made to combine the teachings of Gardner and Nattkemper because

Nattkemper's teaching would allow one to determine the connection path so that communication can be established in a proper manner." (Office Action, Page 3). First, even assuming this were true and that this motivation was actually present in the references, it would have no bearing on Applicants' claims. The Examiner has done nothing more than propose an alleged advantage (and one which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes) of combining *Gardner* with *Nattkemper*. The Examiner has not pointed to any portions of either *Gardner* or *Nattkemper* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the broadband telecommunications system interface disclosed in *Gardner* with the distributed telecommunications switching system and method disclosed in *Nattkemper*. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the broadband system interface disclosed in *Gardner* such a distributed telecommunications switching system as the one disclosed in *Nattkemper*. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the broadband system interface disclosed in *Gardner* such a distributed telecommunications switching system, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Gardner* with *Nattkemper* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner's proposed combination of *Gardner* with *Nattkemper* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims and is unsupported by the teachings of *Gardner* and *Nattkemper*. Applicants respectfully submit that the rejection must therefore be withdrawn.

Second, as demonstrated above, Applicants respectfully submit that *Gardner* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Nattkemper*

discloses the portions of Claim 1 that the Examiner suggests (with which Applicants do not agree), and even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Gardner* with *Nattkemper* as the Examiner proposes, the proposed *Gardner-Nattkemper* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependent claims. For at least the reasons stated with regard to independent Claim 1, Applicants respectfully request reconsideration and allowance of independent Claims 12, 20, 30, 38, 43, and 48, together with all of their respective dependent claims.

Claims 2-5 and 8-11 (which depend from Claim 1), Claims 13-19 (which depend from Claim 12), Claims 21-23 and 26-29 (which depend from Claim 20), Claims 31-37 (which depend from Claim 30), Claims 39-40 (which depend from Claim 38), Claims 44-45 (which depend from Claim 43), and Claims 49-55 (which depend from Claim 48) depend from allowable independent claims and are allowable for at least this reason. In addition, Claims 2-5, 8-11, 13-19, 21-23, 26-29, 31-37, 39-40, 44-45, and 49-55 recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of Claims 1, 12, 20, 30, 38, 43, and 48, as described above, Applicants do not specifically discuss in this Response the patentable distinctions of Claims 2-5, 8-11, 13-19, 21-23, 26-29, 31-37, 39-40, 44-45, and 49-55. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-5, 8-11, 13-19, 21-23, 26-29, 31-37, 39-40, 44-45, and 49-55.

II. Dependent Claims 6-7, 24-25, 41-42, and 46-47 are Allowable over the Proposed *Gardner-Nattkemper-Ball* Combination

The Examiner rejects Claims 6-7, 24-25, 41-42, and 46-47 under 35 U.S.C. § 103(a) as being unpatentable over *Gardner* in view of *Nattkemper*, and further in view of U.S. Patent 6,446,200 to Ball ("*Ball*"). Claims 6-7, 24-25, 41-42, and 46-47 depend from independent

Claims 1, 20, 38, and 43, respectively, which Applicants have shown above to be clearly allowable. Applicants respectfully submit that *Ball* fails to make up for any of the deficiencies of *Gardner* and *Nattkemper* discussed above. Thus, Claims 6-7, 24-25, 41-42, and 46-47 are allowable at least because of their dependence on Claims 1, 20, 38, and 43, respectively. In addition, Claims 6-7, 24-25, 41-42, and 46-47 recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of Claims 1, 20, 38, and 43, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicants do not admit that the proposed combination of *Gardner*, *Nattkemper*, and *Ball* is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 6-7, 24-25, 41-42, and 46-47.

III. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Gardner*, *Nattkemper*, and *Ball* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the obviousness rejections.

Conclusion

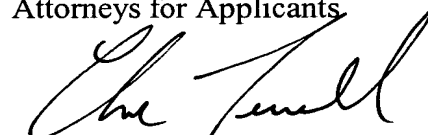
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read "Chad D. Terrell", is written over the printed name.

Chad D. Terrell
Reg. No. 52,279

Date: July 7, 2004

BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Tel. (214) 953-6581